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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/162,444    09/29/98    TANAKA    A    500.31108CC4

020457    LM21/0103  
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EXAMINER

NGUYEN, H

ART UNIT

PAPER NUMBER

2784

DATE MAILED:

01/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

**09/162,444**

Applicant(s)

**TANAKA ET AL**

Examiner

**HOA NGUYEN**

Group Art Unit

**2784**☒ Responsive to communication(s) filed on Oct 14, 1999☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 18-22, 24, and 26-31 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 18-22, 24, and 26-31 is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☒ The proposed drawing correction, filed on Sep 29, 1998 is ☒ approved ☐ disapproved.☒ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.☒ received in Application No. (Series Code/Serial Number) 08/859,850.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 (copy)☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152**--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---**

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### DETAILED ACTION

The amendment filed on 10/14/99 has been entered into the record. Applicant serial number 08/895986 cited on PTO-1449 filed on 9/29/98 has been considered and is hereby made of record.

1. A substitute specification excluding claims is required pursuant to 37 CFR 1.125(a) because, as requested in the last office action, the lengthy of amendments made to the specification (filed on 9/29/98) has not been entered into the record. This requirement is repeated.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

#### Examiner's remarks:

Applicant argues that same length of amendments were made to the original specification of parent applications were entered into the record and that these applications were examined by the same examiner who is presently examining this application. Therefore, applicant requests that the requirement for a substitute specification be withdrawn and the changes to the specification in the preliminary amendment of 9/29/98 be entered. In response to this argument, the examiner asserts that entering the amendments is done by a legal instrument examiner (LIE) not the examiner of

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record. And the LIE who enters papers for this application is not necessary to be the same to that of in the parent applications. Beside, the other LIEs who took extra effort to enter the lengthy amendments in the parent applications does not mean that this LIE must do the same.

2. In light of the personal interview with applicants and their representatives on 11/17/99, corrections to figure 9 have approved by the examiner.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide proper antecedent basis for the claimed limitations in claims 22, 24, 26-30. Please note citations and explanations set forth in paragraph 6 of the last office action correspondingly.

4. The amendment filed 9/29/98 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The original specification fails to provide support for the limitations of claims 22, 24, 26-30. Please see explanations and citations set forth in paragraph 7 correspondingly.

Applicant is required to cancel the new matter in the reply to this Office action.

**Examiner's remarks:** During the personal interview of 11/17/99, applicant argues that figure 9 element 198 provide support to the issues raised to claims 22, 24, 26-30 in the objections of

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failing to provide proper antecedent basis and introducing of new matter. However, as discussed during the interview, figure 9 and element 198 when considered together with their corresponding description in the specification fails to clarify proper antecedent basis and support as required.

Therefore, the objections are repeated.

5. Claims 22, 24, 26-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Please note comments and citations with respect to paragraphs 3&4 above.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 18-22, 24, 26-31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 18:** Lines 7-9, "the storage units in which a fault has occurred" lacks antecedent basis. Further, the claim lacks of essential structure/function to provide support for this limitation. Further, "a corresponding one of the data groups and corresponding error correcting data" lacks antecedent basis. **Claims 21, 22, 24, 26-30** contain the same issue to that of **claim 18**.

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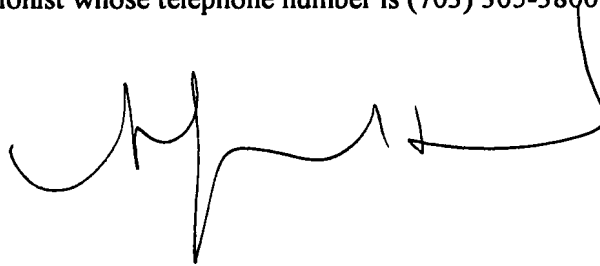
**Claims 20, 27-30:** Lines 4 & 10 respectively, "a host" is an indirect limitation which is vague and indefinite as to if applicant means to claim the host as a part of the apparatus or not.

Claims which have not been mentioned are rejected because they are dependent on the rejected independent claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa Nguyen whose telephone number is (703) 305-9687.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady, can be reached on (703) 305-9595. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to read 'H. Nguyen', with a long horizontal stroke extending to the right.

HOA T. NGUYEN  
PRIMARY EXAMINER  
AU 2784